



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/787,508

02/25/2004

Gerald E. Bennington

UV-133 Cont. 6 Div.

7296

1473

7590

04/18/2006

FISH & NEAVE IP GROUP

ROPES & GRAY LLP

1251 AVENUE OF THE AMERICAS FL C3

NEW YORK, NY 10020-1105

EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,508

Applicant(s)

BENNINGTON ET AL.

Examiner

Scott Beliveau

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2004-02-25</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 121.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 08/119,367, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The common elements in the claims associated with "simultaneously displaying with the plurality of program listings at least a substantial portion of a video that is accompanied by audio" does not appear to be supported. In particular, the specification, as originally filled is entirely silent with respect to the usage/existence of audio and is further silent with respect to the particular display of a plurality of listings simultaneously with the displayed video segment. For example, as illustrated in Figure 11, only a single program listing is displayed at any given time with the corresponding video. Accordingly, the application is being examined based upon its filing or 24 February 2004.

Information Disclosure Statement

2. The information disclosure statement filed 25 February 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered unless noted. In particular, upon review of the earlier filled references associated with the parent applications 10/346,266, 09/997,659, and 08/119,367, the examiner was unable to locate copies of a majority of the foreign patent documents as well as the non-patent literature indicated.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of “in response to a user navigating to a particular program listing of the plurality of program listings, simultaneously displaying with the plurality of program listings at least a substantial portion of video that is accompanied by audio and that is associated with the particular program listing using the interactive television program guide” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of

the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because of its length. Correction is required. See MPEP § 608.01(b). Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

Double Patenting

5. The instant application and its lineage appear to be related to at least 15 co-pending applications. In order to reasonably evaluate the claims of the instant application with respect to potential double patenting rejections, applicant's assistance is respectfully requested in providing the examiner with an identification of those pending or issued applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose and claim similar subject matter to that of the instant application.

With respect to co-pending application 09/997,659, the claims appear to be directed towards similar subject matter as the instant application. However, at this time and after speaking with the examiner responsible for that application (Michael Lee), the examiner is unable to view the current version of the claims (as opposed to older versions of the claims circa 14 February 2002) which had been allowed due to IFW processing problems. No further action is required by applicant's at this time; however, once the particular claims become available for review a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be subsequently requested.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

Art Unit: 2623

reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 31-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Patent No. 6,418,556 in view of Young et al. (US Pat No. 5,353,121).

Claim 31 of the instant application corresponds to claim 11 of the earlier patent. In particular, the earlier claim sets forth a “method for using an interactive program guide to display for a user video . . . on a display on which program listings are displayed, comprising: displaying . . . program listings using the interactive television guide; allowing the user to navigate through the . . . program listings”. The earlier filled claim is silent with

respect to the display of “video that is accompanied by audio” as well as the particular display of a “plurality of program listings” in association with the displayed video.

In an analogous art pertaining to the interactive program guides, the Young et al. discloses the particular display of a “user video that is accompanied by audio” and a “plurality of program listings” whereupon “in response to a user navigating to a particular program listing of the plurality of program listings, simultaneously displaying with the plurality of program listings at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” (Young et al. Figures 26 A/B; Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the patented claim such that the “video . . . is accompanied by audio” and the “plurality of program listings” is displayed in association with the displayed video for the purpose of advantageously providing a background scrolling guide which does not require the need to master advanced navigation commands of the full-screen guides and further usefully takes advantage of limited display space (Young et al.: Col 23, Lines 36-62).

Claim 33 corresponds to patented claim 1 wherein the patented “means for displaying” corresponds to the claimed “video display generator” and its associated output device, the “means for allowing” corresponds to the claimed “user control means”, and the “means for simultaneously displaying” corresponds to the claimed “data processing means”. As aforementioned, the earlier claim is silent with respect to the display of “video that is accompanied by audio” as well as the particular display of a “plurality of program listings” in

association with the displayed video. Young et al. discloses a “means for displaying a plurality of program listings using the interactive television program guide” [210], “means for allowing the user to navigate through the plurality of listings” [212/214], and “means for simultaneously displaying with the plurality of program listings, in response to a user navigating to a particular program listing of the plurality of program listings, at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” [228] (Figures 26 A/B; Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the patented claim means such that the “video . . . is accompanied by audio” and the “plurality of program listings” is displayed in association with the displayed video for the purpose of advantageously providing a background scrolling guide which does not require the need to master advanced navigation commands of the full-screen guides and further usefully takes advantage of limited display space (Young et al.: Col 23, Lines 36-62).

Claim 35 similarly corresponds to claim 1 of the earlier patent wherein the differences lie in the particular display of “video that is accompanied by audio” as well as the particular display of a “plurality of program listings” in association with the displayed video. Figures 22 A/B of the Young et al. reference illustrate a “system for using an interactive television program guide to display for a user video that is accompanied by audio on a display on which program listings are displayed”. The system comprises a “remote control” [212/214], a “display device” [210], and “control circuitry” [238]. The “control circuitry” [238] is

“directs the display device to display a plurality of program listings using the interactive television program guide”, “allows the user to navigate through the plurality of listings”, and “directs the display device to simultaneously display with the plurality of program listings, in response to a user navigating to a particular program listing of the plurality of program listings, at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” [228] (Figures 26 A/B; Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the patented claim means such that the “video . . . is accompanied by audio” and the “plurality of program listings” is displayed in association with the displayed video for the purpose of advantageously providing a background scrolling guide which does not require the need to master advanced navigation commands of the full-screen guides and further usefully takes advantage of limited display space (Young et al.: Col 23, Lines 36-62).

Claim 37 of the instant application corresponds to claim 11 of the earlier patent wherein the particular usage of a “data storage medium . . . comprising program logic recorded thereon” so as to perform the method as recited in claim 31 is considered to be obvious over the patented claim in view of the Young et al. “data storage medium” [240] utilized to implement the aforementioned method.

Claims 32, 34, 36, and 38 correspond to claims 1 and 11 of the patented claim respectively wherein the Young et al. reference teaches that “simultaneously displaying at

least a substantial portion of a video comprises simultaneously displaying a complete video in a reduced size video window” as illustrated in Figures 26 A/B.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 31-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the common limitation of “in response to a user navigating to a particular program listing of the plurality of program listings, simultaneously displaying with the plurality of program listings at least a substantial portion of video that is accompanied by audio and that is associated with the particular program listing using the interactive television program guide” has not been described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to the particular limitation such that the user video is accompanied by audio, the specification as originally filled, is silent with respect to the particular usage of audio and it being associated with the displayed video. NTSC formatted video need not necessarily be accompanied by audio. With respect to the particular limitation regarding the display of the plurality of program

listings simultaneously with the video, as illustrated in Figure 11, the reference only illustrates the display of a single program listing in association with the displayed video. While, it is contemplated that a plurality of television listings may be displayed in succession with one another in conjunction with browsing through the listings, doing so does not support the claimed limitation such that “in response to a user navigating to a particular program listing of the plurality of program listings, simultaneously displaying with the plurality of program listings at least a substantial portion of video . . . that is associated with the particular program listing using the interactive television program guide”.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 31-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al. (US Pat No. 5,353,121).

In consideration of claim 31, Figures 26 A/B of the Young et al. reference discloses a “method for using an interactive television program guide to display for a user a video that is accompanied by audio on a display on which program listings are displayed”. As illustrated the method entails” displaying a plurality of program listings using the interactive program guide” [3110/3120]. The method “allowing the user to navigate through the plurality of program listings” and “in response to a user navigating to a particular program listing of the

plurality of program listings, simultaneously displaying with the plurality of program listings at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” (Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60).

In consideration of claim 33, Figures 22 A/B of the Young et al. reference illustrate a “system for using an interactive television program guide to display for a user video that is accompanied by audio on a display on which program listings are displayed”. The system comprises “means for displaying a plurality of program listings using the interactive television program guide” [210], “means for allowing the user to navigate through the plurality of listings” [212/214], and “means for simultaneously displaying with the plurality of program listings, in response to a user navigating to a particular program listing of the plurality of program listings, at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” [228] (Figures 26 A/B; Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60).

In consideration of claim 35, Figures 22 A/B of the Young et al. reference illustrate a “system for using an interactive television program guide to display for a user video that is accompanied by audio on a display on which program listings are displayed”. The system comprises a “remote control” [212/214], a “display device” [210], and “control circuitry” [238]. The “control circuitry” [238] is “directs the display device to display a plurality of program listings using the interactive television program guide”, “allows the user to navigate through the plurality of listings”, and “directs the display device to simultaneously display

with the plurality of program listings, in response to a user navigating to a particular program listing of the plurality of program listings, at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” [228] (Figures 26 A/B; Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60).

In consideration of claim 37, Figures 26 A/B of the Young et al. reference discloses a “data storage medium” [240] for “an interactive television program guide system that displays for a user a video that is accompanied by audio on a display on which program listings are displayed”. “The program logic” enables the system to “display a plurality of program listings using the interactive program guide” [3110/3120], “allow the user to navigate through the plurality of program listings” and “in response to a user navigating to a particular program listing of the plurality of program listings, simultaneously displaying with the plurality of program listings at least a substantial portion of a video that is accompanied by audio” (ex. ‘Ducktales’) and “that is associated with the particular program listing using the interactive television program guide” (Col 24, Line 9 – Col 25, Line 24; Col 26, Lines 27-60).

Claims 32, 34, 36, and 38 are rejected wherein “simultaneously displaying at least a substantial portion of a video comprises simultaneously displaying a complete video in a reduced size video window” as illustrated in Figures 26 A/B. As illustrated, the particular display of video information comprises a “reduced size video window” in so far as a portion of the illustrated full sized video window has been overlaid with the program guide information. Therefore, the size has effectively been ‘reduced’. The video is construed as

'complete' in so far as the user could watch the entire program using the background mode if desired.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The IMDB article "DuckTales" provides evidence that the particularly illustrated video of Young et al. is accompanied by audio (ex. Mono or that audio associated with the voice actors indicated).
- The Moro et al. (EP 444 496 A1) reference discloses a system and method for displaying a plurality of program listings simultaneously with at least a substantial portion of a video.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

Art Unit: 2623

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SEB
April 10, 2006

Scott Beliveau
Examiner
Art Unit 2623